

REMARKS

Claims 21 to 26 are added, claims 16 and 17 are canceled without prejudice, and therefore claims 11 to 15 and 18 to 26 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Office Action, the specification was objected to for informalities. While the objection may not be agreed with, to facilitate matters, a paragraph has been inserted without prejudice beginning at page 1, line 1 of the Substitute Specification, as suggested. Approval and entry are respectfully requested. It is therefore respectfully requested that the objection be withdrawn.

With respect to paragraph four (4) of the Office Action, claims 11 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,334,998 (the Murakami reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 11 has been rewritten herein without prejudice to provide *at least one further decoupling element for a different frequency range*, in which *the decoupling element for the FM reception and the at*

least one further decoupling element are galvanically connected at connection ends of the decoupling elements.

The Murakami reference does not identically disclose (or even suggest) the feature of *at least one further decoupling element for a different frequency range*, as provided for in the context of claim 11, as presented. As an initial matter, the Office Action does not even assert that the Murakami reference discloses this feature. Further, the Murakami reference merely refers to an FM main antenna 4 and an FM subsidiary antenna 18. (Murakami, col. 5, lines 25 to 47). However, nowhere does the Murakami reference identically disclose (or even suggest) that the FM subsidiary antenna 18 is for a different frequency range. Moreover, the Murakami reference also does not identically disclose (or even suggest) that *the decoupling element for the FM reception and the at least one further decoupling element are galvanically connected at connection ends of the decoupling elements*. Thus, the Murakami reference does not identically disclose (or even suggest) all of the features of claim 11, as presented.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 12 to 15 ultimately depend from claim 11 and are therefore allowable for at least the same reasons as claim 11.

Accordingly, it is respectfully submitted that claims 11 to 15 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph five (5) of the Office Action, claims 11, and 16 to 19 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2004/0056810 (the Oka reference). As an initial matter, claims 16 and 17 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 16 and 17.

The Oka reference does not identically disclose (or even suggest) that *the decoupling element for the FM reception and the at least one further decoupling element are galvanically connected at connection ends of the decoupling elements*, as provided for in the context of claim 11, as presented. The Office Action at page 5 appears to assert that Figure 12 of the Oka reference discloses two galvanically connected decoupling elements 51. However, the Oka reference specifically states that “the first antenna element 51 has a two-tine fork pattern.” (Oka, ¶ 73). Thus, the Oka reference clearly indicates that the two tines of element 51 constitute only a single decoupling element. Further, the Oka reference explicitly states that “[t]he first and second antenna elements 51 and 52 and the defogging heater 3 are

not connected directly to one another.” (Oka, ¶ 45). Therefore, the Oka reference makes plain in its specification and drawings that no decoupling elements are directly connected to one another. Thus, the Oka reference does not identically disclose (or even suggest) all of the features of claim 11, as presented.

Accordingly, it is respectfully submitted that claim 11, as presented, is allowable. Claims 18 and 19 depend from claim 11 and are therefore allowable for at least the same reasons as claim 11.

Accordingly, it is respectfully submitted that claims 11, 18, and 19 are allowable.

Withdrawal of the rejections of the claims is therefore respectfully requested.

With respect to paragraph seven (7) of the Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Murakami reference, in view of U.S. Patent No. 6,201,506 (the Endo reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the Murakami reference does not disclose or even suggest all of the features of claim 11, as presented. Claim 20 depends from claim 11 and is therefore

allowable for essentially the same reasons provided above, since the Endo reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Murakami reference.

Withdrawal of the rejection is therefore respectfully requested.

New claims 21 to 26 do not add any new matter and are supported by the present application, including the specification. Claims 21 to 26 depend from claim 11, and are therefore allowable for the same reasons as claim 11, as presented.

In sum, claims 11 to 15 and 18 to 26 are allowable.

Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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